

**REMARKS**

This amendment responds to the Office Action mailed on April 5, 2007. The shortened statutory period for response is set to expire on July 5, 2007. Accordingly, applicant respectfully submits that this response is being timely filed.

Claims 1-30 were pending in the present application. Claims 25-28 were allowed and claims 8-13, 17, 18 and 23 were indicated as containing allowable subject matter in the Office Action. By the above amendment, claims 1, 5-7, 9, 12, 17, 18, 20, 25, 27 and 29 have been amended and new claims 31-34 have been submitted for examination on their merits. Accordingly, Claims 1-34 are now pending in the present application, and applicant believes these claims are in proper condition for allowance for the reasons set forth below.

In the pages that follow below, Applicants will set forth in detail that:

- 1) Claims 16-24 are directed to statutory subject matter under 35 U.S.C. § 101;
- 2) the cited prior art fails to teach or suggest recording a multi-digit security code into a motion picture copy using a plurality of symbols with each symbol representing a digit of the code; and
- 3) the cited prior art fails to teach or suggest inserting a coded identification number into a motion picture copy by forming marks resembling defects into the frames of the motion picture copy.

**Claim Rejections Under 35 U.S.C. § 101**

The Office Action rejected claims 16-24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection and reconsideration is requested based on the following remarks.

Claims 16-24 are directed to a motion picture film copy or a motion picture film print bearing special marks having the appearance of defects in order to impart coded identification information into the motion picture film copy or a motion picture film print.

35 U.S.C. § 101 recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

A motion picture film copy or a motion picture film print is a “manufacture” that falls within a statutory category of patent eligible subject matter under § 101. Applicants respectfully set forth that a motion picture film copy is an article of manufacture and not merely a compilation of data that could be considered an abstract idea.

The proper examination procedures for determining whether claims are eligible for patent protection under § 101 are set forth in MPEP § 2106, which states that even claims that are directed to an abstract idea are eligible for patent protection if the claimed invention is directed to a practical application. A claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it produces a useful, concrete and tangible result. *See MPEP § 2106*. A motion picture film copy or a motion picture film print bearing special marks that serve to identify the film copy or film print are useful, concrete and tangible products that have a specific practical application, and thus are eligible for patent protection under § 101.

Further evidencing this fact, it should be noted that the U.S. Patent and Trademark Office has consistently and repeatedly over time found that motion picture films having specific information coded thereon are patentable, as can be seen from the following issued U.S. patents that were identified after a very brief search of the USPTO records:

<u>U.S. Patent No.</u>	<u>Claim Recitation</u>
4,308,327	1. A motion picture release print produced by . . .
4,366,217	1. An exposed and developed motion picture release print, comprising: ...
4,577,305	1. A motion picture film having a photographic sound-track for selective reproduction of monophonic sound . . .
5,675,379	10. A recording medium having recorded thereon moving picture signals having a bit stream obtained from ...

<u>U.S. Patent No.</u>	<u>Claim Recitation</u>
5,864,368	26. A signal recording medium having recorded thereon encoded picture signals produced by ...
5,991,500	7. A video signal record medium having recorded thereon a video signal comprised of ...
7,206,409	22. A security coded motion picture disposed on a media comprising: ...  49. A security coded motion picture comprising: a motion picture recording comprised of a plurality of frames, ...

As can be seen, the USPTO has repeatedly found that motion picture film prints are a type of media that are eligible for patent protection, and Applicants respectfully submit that the claimed motion picture film copy and motion picture film print are manufactures having a practical application that clearly fall within a statutory category of patent eligible subject matter under § 101. Reconsideration of the rejection of claims 16-25 is hereby requested.

#### **Claim Rejections Under 35 U.S.C. § 102**

The Office Action rejected claims 1-7, 16, 19-22, 24, 29 and 30 under 35 U.S.C. § 102(b) as being anticipated by *Ryota et al.*(EP 0 899 688 A3). Applicants respectfully traverse this rejection and reconsideration is requested in view of the above amendments and based on the following remarks.

#### **The Cited Prior Art Fails to Teach or Suggest Recording a Multi-Digit Security Code Into a Motion Picture With Each Recorded Symbol Representing a Digit of the Code**

Independent claim 1 has been amended above to recite that the recording equipment records a plurality of separate coded symbols onto the motion picture record medium, each symbol representing a digit of a multi-digit security code and being recorded in a separate frame of the recorded motion picture.

Applicants note that *Ryota* discloses inserting a watermark indicative of the ownership of a copyright into a moving image, such as by inserting the written copyright information (e.g.,

“Fujitsu Labs © 1997” as shown in FIG. 10) into certain frames of the moving image. Alternatively, rather than using written letters, *Ryota* discloses that the inserted copyright information can be represented by a pattern, as illustrated in FIG. 17. Whether using written letters or a pattern, this same watermark indicative of the copyright is repeatedly inserted into various frames of the moving image. However, *Ryota* fails to teach or suggest inserting a multi-digit security code into the moving image. Still further, *Ryota* fails to teach or suggest recording a plurality of separate coded symbols into the moving image, where each symbol represents a digit of a multi-digit security code and each symbol is recorded in a separate frame of the moving image. As such, *Ryota* fails to teach or suggest all of the limitations of amended claim 1, and it is respectfully submitted that independent claim 1 and its respective dependent claims are allowable over the cited prior art of record.

Furthermore, independent claim 29 recites a method comprising recording a separate predetermined pattern or defects for each one of the characters in a plurality of characters that are recorded in a motion picture film recording. While *Ryota* discloses that a pattern can be inserted to serve as watermark information, *Ryota* fails to teach or suggest recording a separate pattern for each character of a plurality of coded alphanumeric characters onto the motion picture film recording. Still further, *Ryota* fails to teach or suggest that each pattern forms part of an alphanumeric sequence representing a code number of the motion picture film recording, as recited in dependent claim 30. Thus, it is respectfully submitted that claims 29 and 30 are not anticipated by *Ryota* and submit that such claims are allowable over the cited prior art of record.

Applicants note that dependent claim 7 recites that each one of the plurality of the recorded symbols comprises a representation of one digit of a multi-digit print identification number, where a unique identification number is provided for each of a plurality of prints of a motion picture. Paragraph [0095] of *Ryota* is cited in the Office Action as disclosing this feature. However, the cited portion of *Ryota* merely describes that a pseudorandom number generator can be used to generate the particular pattern that contains the copyright indication information, where the pattern will not necessarily be unique to that particular moving image as it could be possible for the same random number to be generated twice. *Ryota* discloses that use of such a pseudorandom number to generate the pattern heightens the degree of complexity of the copyright information but does not suggest that the copyright information will necessarily be

unique. Still further, the generated pattern in *Ryota* is still a single pattern that represents the copyright information and *Ryota* does not disclose that the generated pattern represents one digit of a multi-digit print identification number, as recited in dependent claim 7. Thus, it is respectfully submitted that dependent claim 7 is separately patentable over the cited prior art for the reasons set forth above.

The Cited Prior Art Fails to Teach or Suggest Forming Marks That Look Like Defects

Claims 2, 16, 24 and 29 recite recording small marks resembling defects onto frames of the motion picture copy in order to insert a coded identification number into the motion picture copy. By camouflaging the marks to look like defects, the marks are unobtrusive to a viewer and are difficult for counterfeiters to locate. If counterfeiters are aware of certain identifiers that are inserted into a motion picture copy, they will try to destroy or otherwise alter the frames having the identifiers in order to mask the origins of the counterfeit copy. Thus, by making the coded identifiers appear as defects in the motion picture copy, the present claims provide a manner of inserting a coded identification number into a motion picture copy that will be difficult for counterfeiters to detect and erase.

Paragraph [0051] of *Ryota* is cited in the Office Action as disclosing this feature recited in claims 2 and 16 of creating small marks in the motion picture that resemble defects. Applicants respectfully disagree with this assertion and submit that *Ryota* actually provides an opposite teaching. The cited portion of *Ryota* in paragraph [0051] discloses that the watermark can be visually perceived “even through the use of, for example, a magnifying glass is needed.” Merely because the watermark may require enlarging to be visually perceived does not equate to the watermark appearing as a defect. In fact, in the same paragraph [0051] from lines 51-55, *Ryota* recites that:

“When the frame bearing the inserted watermark is viewed in the static state, the copyright information needs to be clearly understood. Herein it is not the essential aim of the present invention to camouflage the copyright information . . .” [emphasis added]

Thus, while claims 2, 16, 24 and 29 of the present application recite inserting a coded identification number using small marks resembling defects in order to hide the coded information, *Ryota* teaches the opposite in teaching that the visible copyright information must

not be camouflaged and needs to be clearly understood when viewed. *Ryota* further describes in paragraph [0049] the embedded copyright information does not distort or degrade the image quality of the moving image such that the quality of the moving image is not damaged. Thus, not only does *Ryota* fail to teach or suggest inserting a coded identification number comprising small marks resembling defects, *Ryota* teaches away from this concept of inserting defects into the moving image by asserting that quality of the moving image is not distorted or degraded by the embedded copyright information. Thus, it is respectfully submitted that dependent claim claims 2, 16, 24 and 29 and their respective dependent claims are not anticipated by the cited prior art, and reconsideration is respectfully requested.

More particularly regarding dependent claim 3, while *Ryota* discloses that a pattern can be inserted to serve as watermark information, *Ryota* fails to teach or suggest that such pattern represents an alphanumeric character, as recited in claim 3. As such, Applicants respectfully submit that dependent claim 3 is not anticipated by the cited prior art of record, and reconsideration is respectfully requested.

More particularly regarding dependent claim 4, while *Ryota* discloses that a pattern can be inserted to serve as watermark information, *Ryota* fails to teach or suggest that the spacing of “specks” in the pattern should be widely spaced from one another so as to be unobtrusive, as recited in claim 4. As such, Applicants respectfully submit that dependent claim 4 is not anticipated by the cited prior art of record, and reconsideration is respectfully requested.

More particularly regarding dependent claim 5, *Ryota* fails to teach or suggest the insertion of a multi-digit security code as recited in claim 5 as amended above and as set forth in more detail above. *Ryota* further fails to disclose that the multi-digit security code comprises a plurality of different symbols, where each of said symbols is recorded in a plurality of different adjacent frames prior to the location of the next symbol component of the multi-digit security code, as recited in claim 5. As such, Applicants respectfully submit that dependent claim 5 is separately patentable over the cited prior art of record, and reconsideration is respectfully requested.

More particularly regarding dependent claim 20, *Ryota* fails to teach or suggest the insertion of a coded identification number having a plurality of different components, where each

of the components is repeated at least once in an adjacent frame before a second component in the plurality of different components that make up the coded identification number is recorded, as recited in claim 20. As such, Applicants respectfully submit that dependent claim 20 is separately patentable over the cited prior art of record, and reconsideration is respectfully requested.

CONCLUSION

In each case, the pending rejections should be reconsidered in view of the amendments and remarks herein. Applicant believes that this case is in good condition for allowance, and a Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned, who will cooperate in any appropriate manner to advance prosecution. The Commissioner is directed and authorized to charge all additional required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 092807-011000 is referred to when charging any payments or credits for this case.

Respectfully submitted,

Bradley D. Blanche  
Reg. No. 38,387

Date: July 2, 2007

Customer Number 33717  
GREENBERG TRAURIG, LLP  
2450 Colorado Avenue, Suite 400E  
Santa Monica, CA 90404  
Phone: (310) 586-7700  
Fax: (310) 586-7800  
E-mail: [laipmail@gtlaw.com](mailto:laipmail@gtlaw.com)